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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,136	01/12/2001	Stephen Nuss	990356.ORI	2264

23595 7590 02/05/2004

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 02/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/760,136

Applicant(s)

NUSS, STEPHEN

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12 - 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 - 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,132,389 to Cornish et al. in view of U.S. Patent Application Publication No. 2003/0009215 to Mayer.

In regards to claims 12 – 27, Cornish et al. discloses a guidewire comprising a titanium alloy core wire having a proximal end and a distal end, the distal end having a smaller diameter than the proximal end; a taper of the diameter between the distal end and the proximal end with the distal end being smaller (Col. 3, line 66 – Col. 4, line 14); a coil (20) attached to the distal end; a distal tip (58) on the distal end; a polymer coating and a hydrophilic coating (Col. 3, lines 50 – 60). Cornish et al. discloses the wire being formed of any suitable material (Col. 3, lines 42 – 47). However, Cornish et al. fails to disclose the titanium alloy being a titanium molybdenum alloy having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by weight. Mayer discloses a medical device for inserting into body passageways during medical procedures including a titanium molybdenum alloy wire having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by weight [0078]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the titanium alloy as disclosed by Cornish et al. to include a titanium molybdenum alloy as taught by Mayer in order to avoid undue irritation to patients having a

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sensitivity to nickel [0079]. Additionally, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Lesbin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Response to Arguments***

3. Applicant's arguments filed 1/16/04 have been fully considered but they are not persuasive. Applicant has asserted that Cornish does not use a Beta III Titanium wire. Applicant also asserts that Mayer reference is not relevant since Mayer is directed to a stent. The examiner agrees that Cornish does not disclose the use of a titanium molybdenum alloy as claimed. However, Mayer teaches the use of such an alloy [0078]. Mayer teaches that such an alloy is favorable in devices inserted into body passageways in order to avoid an undue irritation to patients having a sensitivity to nickel [0079]. Since the device inserted into a body passageway as disclosed by Cornish et al. is formed of a titanium alloy comprising nickel, it would have been obvious to one having skill in the art, in view of Mayer, to replace the nickel containing titanium alloy with the titanium molybdenum alloy as taught by Mayer in order to avoid undue irritation to patients having a sensitivity to nickel [0079]. The Mayer reference is relevant in that it, as well as the Cornish et al. reference, are directed to devices inserted into body passageways during medical procedures.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

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the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9306 for regular communications and (703)-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.



JMLF  
February 3, 2004



MAX F. HINDENBURG  
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